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HEWLETT-PACKARD COMPANY			ENG, DAVID Y	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 10/059,083

Filing Date: January 28, 2002

Appellant(s): SIMPSON ET AL.

DEC 13 2007

Technology Center 2100

Jack H. McKinney
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 14 2007 appealing from the Office action mailed February 13 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,975,419	Staas et al	12-2005
6,978,313	Pietrowicz	12-2005
5,751,961	Smyk	5-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8, 10-11, 13-17 and 19-24 stand rejected under 35 U.S.C. 102(e) as being clearly anticipated by Staas (USP 6,975,419).

See at least the abstract, Figures 1, 3 and 6 in Staas.

With respect to claims 1, 10, 11, 15, 19 and 24 Staas teaches:

A method of transmitting a message (Figure 3A, 3B), the method comprising:
determining if a device encounters an event (step 339, Fig. 3B;) while processing a job (print job);
determining If the job meets a pre-determined criterion (step 339, Fig. 3B; steps 446, 456 and 463 Fig. 6A); and

transmitting a message to a remote destination (steps 343 Fig. 3B; 449 and 459 Fig. 6A) when each of a set of pre-determined conditions exist, the pre-determined conditions include:

a determination that the device encountered the event (Y in the above identified diamond steps of Figure 3 and 6) while processing the job; and

a determination that the job met (Y in the above identified diamond steps of Figure 3 and 6) the pre-determined criterion.

In claims 2 and 17, the device in Staas is a printer.

In claims 3-6, 13-14, 21 and 23, see steps 339, 343, 346 of Figure 3B, steps 446, 449, 456, 459, 463, 476 of Figure 6A and claim 31 for successful.

In claim 7, the steps recited therein are inherent in submitting print job.

In claims 8, 16, and 22, transmitting messages in Staas requires IP address and email.

Further with respect to step (a) of claim 10, step (bi) of claim 15 and claim 20, see column 5 line 39-54.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Staas (USP 6,975,419) further in view of Pietrowicz (USP 6,978,313).

Staas teaches claim combination set forth above. It does not appear that Staas teaches paging. Paging is well known in the art. See lines 27-41 of column 2 in Pietrowicz. From the teaching of Pietrowicz, it would have been obvious to a person of

ordinary skill in the art to page the sender when events are encountered such that attention can be brought to the person being paged immediately.

Claims 12 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Staas (USP 6,975,419) further in view of Smyk (USP 5,751,961).

Staas teaches claim combination set forth above. It does not appear that Staas teaches hyperlink. Transmitting message including hyperlink is well known in the art. Smyk teaches transmitting message including hyperlink. See lines 1-9 column 4 in Smyk. From the teaching of Smyk, it would have been obvious to a person of ordinary skill in the art to include a hyperlink in the message of Staas such that the recipient is able to go to a web cite.

(10) Response to Argument

At the outset, Appellants probably mean step 339 and not 329 as stated in line 1 of the second last paragraph on page 5 of their brief. In the Office action mailed on 8/31/2006, the Examiner relied on step 339 and not step 329 in the rejections.

The Claimed Invention

Although the preambles of the claims call for a method of transmitting a message, there is no method of transmitting steps recited in the claims. Rather, Appellants' disclosed and claimed invention is a method (see the title and the flow chart shown in Figure 11) of informing a user the progress of a print job (making paper copies of a file or document). The claim combination broadly recites that a message (email,

see line 10 page 13 of Appellants' specification) is sent to a user (1) if an event is encountered (see Appellants' definition of event in lines 9-22 of page 13) during processing a job (print job) and (2) if a criterion is met (see Appellants' definition of criterion in line 28 of page 15 to line 2 of page 16).

The Staas Reference

Staas's system is not designed for merely printing an email as argued by Appellants (first paragraph, page 5 of the brief). Staas's system is for printing a document attached to an email (see lines 41-43 of column 5 in Staas) or stored in memory remote from the user or the print site (see lines 18-21 of column 3 and lines 7-23 of column 7 in Staas). More importantly, Staas, in addition, also teaches a method of informing a user the progress of a print job (Figures 3 and 6) identical to Appellants' claimed invention (Figure 11).

Argument, Claim 1

Appellants agree that Staas teaches the step of informing the sender via email when an error is encountered during processing of a print job (second last paragraph, page 5). Appellants argued that Staas does not teach sending a message to a sender when an event is encountered and (Appellants' emphasis) a criterion is met. The Examiner disagrees. In lines 9-22 of page 13 of the specification, Appellants define what "events" are. The term "events" is defined as: any type of error or alert condition, including failure or **successful** (Examiner's emphasis) of the print job. Obviously, a print job can not be successful if criterion is not met. Therefore the definition of event as defined in the specification includes the definition of criteria. Staas teaches, in Figure 3B

that a message is sent to a user if the print job is successful (346). Again, a print job can not be successful if criterion is not met. Therefore, when a successful message is sent in Staas, an event (the event of successful) has occurred **and all criteria are met (the print job is successful)**.

In addition, Staas also teaches sending a message to the user if criterion such as format is not met. See 449, 459 and 486 in Figure 6 of Staas.

Appellants fail to provide any arguments as to why the feature of sending a message only when there is an event (**error**) occurred **and when a criterion is met** is patentable distinct with respect to the applied art. Appellants fail to give at least one example of the situation and identifying what the message would indicate to the sender in this situation.

Arguments, Claim 10

Appellants rely on the same feature in claim 1 for patentability. Claim 10 therefore stand or fall with claim 1.

Arguments, Claim 15

Appellants rely on the same feature in claim 1 for patentability. Claim 15 therefore stand or fall with claim 1.

Arguments, Claim 19

Appellants rely on the same feature in claim 1 for patentability. Claim 19 therefore stand or fall with claim 1.

Arguments, Claim 9

Appellants rely on the same feature in claim 1 for patentability. Claim 19 therefore stand or fall with claim 1.

Arguments, Claim 12 and 18

Appellants rely on the same feature in claim 1 for patentability. Claims 12 and 18 therefore stand or fall with claim 1.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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